

### **REMARKS/ARGUMENTS**

Claims 1-40 are pending in the present application. In the Office Action mailed December 14, 2004, the Examiner rejected claims 1-8, 10, 13-24, 26, 29-38 under 35 U.S.C. § 102. The Examiner also rejected claims 9, 11, 12, 25, 27, 28, 39, and 40 under 35 U.S.C. § 103. Claims 1, 13, and 29 have been amended.<sup>1</sup>

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

#### **A. Claims 1-8, 10, 13-24, 26, 29-38 Rejected Under 35 U.S.C. § 102(e)**

The Examiner rejected claims 1-8, 10, 13-24, 26, 29-38 under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0112014 to Bennett et al. (hereinafter, "Bennett"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Each independent claim in the present application (the "Application"), and thus each dependent claim, requires, among other things:

- Receipt at or transmission to a wireless device of a "plurality of preconfigured messages from the message web site based on a user identification";

---

<sup>1</sup>These amendments respond to concerns expressed by the Examiner in an interview of March 4, 2005 and merely clarify the meaning of the term "preconfigured messages," rather than further limiting this term. In particular, these amendments clarify that the term "preconfigured messages," as used in the specification and the claims, refers to messages that are preconfigured (formulated or worded) to be sent by a user of the wireless device to a recipient, *i.e.*, that the messages are not directed to the user of the wireless device and then merely forwarded by the user to a recipient. *See, e.g.*, p. 2, lines 5-11; p. 9, lines 4-6; p. 10, lines 4-14; and Figure 8-9.

- Enabling "the user to select the message from the plurality of preconfigured messages";
- Sending the selected "message to the recipient through the global computer network."

(Claim 1; see also independent claims 13 and 29).

Bennett does not teach or disclose these limitations. Instead, it teaches the transmission of a message containing a keyword to a server, the gathering of information ("such as stock quotes or weather" reports) at the server based on the keyword in the message, followed by transmission of the gathered information to the original sender or another recipient. (Bennett, ¶¶ 0095-0104.) Bennett simply does not teach the receipt of a plurality of preconfigured messages at a wireless device for review and selection by the user of that device. In fact, the user may transmit unrecognized and invalid keyword, causing the system to generate an error message. (Bennett, ¶ 0104.) Such an error does not occur with the present invention because the user can view and select from a list of preconfigured messages viewable at the wireless device.

In addition, Bennett further fails to teach that the plurality of preconfigured message are based on a user identification, i.e., the plurality of preconfigured messages may be customized by and to a particular user.

Accordingly, the claimed invention provides substantial advantages over Bennett. Because the preconfigured messages are viewable at the wireless device in the claimed invention, the user is not required to remember keywords, but merely selects from a list of preconfigured messages received from the server. Furthermore, the user may have a customized list of preconfigured messages for use with the wireless device. The claimed device thus significantly facilitates the creation of messages to be sent to a recipient from a wireless device. Application, p. 2, lines 5-11.

Bennett clearly fails to teach the limitations of the present invention "in as complete detail as is contained in the ... claim[s]" (MPEP 2131), and claims 1-8, 10, 13-24, 26, 29-38 are thus allowable over the cited art.

B. Rejection of Claims 9, 11, 12, 25, 27, 28, 39, and 40 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9, 11, 12, 25, 27, 28, 39, and 40 under 35 U.S.C. § 103(a) based on Bennett in view of U.S. Publication No. 2002/0087656 to Gargiulo et al. (hereinafter, "Gargiulo"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

As shown above, Bennett fails to teach the three limitations identified above. Gargiulo likewise fails to teach these limitations. Gargiulo, in fact, teaches the transmission of multimedia content (e.g., ringing tune data) from a server to a requesting device. Gargiulo, ¶¶ 0012-13. For example, like Bennett, Gargiulo fails to disclose the transmission of content, which was received from the server, from the requesting device to a "recipient through [a] global computer network." See, e.g., Application, claim 1. Neither Bennett, Gargiulo, nor a combination of the two teach the receipt of preconfigured messages at a wireless device, selection of one of the messages, and sending the selected message to a recipient through a global computer network. Gargiulo and Bennett, even when combined, do not teach all the limitations of the claimed invention and thus do not render the claimed invention obvious.

In addition, the Examiner has failed to identify a legally adequate motivation to combine the references. The Examiner asserts that:

[I]t would have been obvious to a person of ordinary skill in the art to substitute the HTML of Bennett with XHTML, XML, or DHTML of Gargiulo because instruction programs capable of interpreting XML, DHTML, or XHTML are able to properly interpret HTML formatted documents.

Office Action, p. 9. This assertion is no more than an argument that the references are compatible,<sup>2</sup> i.e., are capable of being combined. The ability to combine references is clearly inadequate to establish a motivation to combine these references. MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.").

Further, the Examiner asserts that "Bennett and Gargiulo are analogous art because they are from the same field of endeavor that is text messaging." Office Action, p. 9 (emphasis added). Gargiulo, however, expressly states that the disclosed invention relates to the distribution of "ringing tone data or other such multimedia content," not text messages. See, e.g., Gargiulo, ¶¶ 0012-13, Title, and Abstract. Thus, Gargiulo and Bennett are clearly not from the same field of art identified by the Examiner and cannot properly be combined to achieve the limitations of the claimed invention.

Accordingly, claims 9, 11, 12, 25, 27, 28, 39, and 40 are not obvious in view of the cited prior art and are allowable over Bennett and Gargiulo.

---

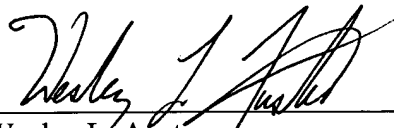
<sup>2</sup> Furthermore, the cited references are not fully compatible. Programs capable of interpreting HTML are not necessarily capable of interpreting XML, DHTML, or XHTML.

Appl. No. 09/928,856  
Amdt. dated March 10, 2005  
Reply to Office Action of December 14, 2004

C. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

  
\_\_\_\_\_  
Wesley L. Austin  
Reg. No. 42,273  
Attorney for Applicant

Date: March 10, 2005

MADSON & METCALF  
Gateway Tower West  
15 West South Temple, Suite 900  
Salt Lake City, Utah 84101  
Telephone: 801/537-1700